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EXAMINER

HERRERA, DIEGO D

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,667	Applicant(s) EJZAK, RICHARD PAUL	
	Examiner Diego Herrera	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/14/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, & 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Drawings

The examiner accepts the corrections made to the drawings.

Claim Objections

Claim 9 is objected to because of the following informalities: claim 9 depends on a cancelled claim 1. Appropriate correction is required.

Response to Arguments

Applicant's arguments filed 4/10/2004 Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

In response to claims 23 and 24, the applicants' features in the claims wherein a method of reporting from the second network receiving the handoff notification request, does read on Ray et al.

Ray et al. is disclosing a notification reply to the handoff notification request sent by the first network, hence the reading on claims 23 and 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 8-11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julka et al. (U.S. Patent # 6,917,810 B2), in view of Ray et al. (U.S. Patent # 6,424,638 B1) and in view of Rygula et al. (US patent 6973309 B1).

1. Regarding claim 1 is cancelled.

2. Regarding claim 23, Julka et al. shows and discloses a method of transferring a packet switched call carried over a first network (Abstract, Title, the abstract explains that there are two different Networks handing over a Mobil user from network to the other without loosing the call connection) to a circuit switched call carried over a second network (Abstract, Title, Fig. 1 and 9, show that there is a circuit switched call carried over to a network from another network), comprising:
 - a. A call transfer request if a handoff request is received, the call transfer request requesting transfer of the packet switched call to a circuit switched call (col. 1, lines: 11-30, col. 9, lines: 60-67, col. 10, lines: 1-10, as explained in these lines, the call transfer request is requesting to have the information transferred).

- b. Except receiving a handoff notification request, the handoff notification request corresponding with a call transfer request if a handoff request is received.

Nonetheless, Ray et al. teaches receiving a handoff notification request, the handoff notification request corresponding with a call transfer request if a handoff request is received (col. 3, lines: 43-65, Fig. 2A, shows the mobile user going from cell 22a to cell 22b and as found in the reference the cell does communicate with the system through a base station to handoff from one system to the other, even though, the figure 2A shows MSC and BSC to be the same for the systems shown, Ray et al. makes it clear in the reference that the system can be the same or different and still be able to communicate, col. 2, lines: 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Surdila et al. to specifically receiving a handoff notification request, the handoff notification request corresponding with a call transfer request if a handoff request is received as taught by Ray et al. for the purpose of being able to convert information from one system to the other to have a reliable handoff (col. 4, lines: 20-25).

However, the combination of Julka et al. and Ray et al. does not disclose the handoff between a packet and a circuit type system, however, Rygula et al. discloses handoff between different systems such as packet and circuit type systems (col. 11 lines: 36-47, col. 13 lines: 36-61, Rygula teaches the ability to handoff calls from one system to a different system with different capabilities).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Julka et al. and Ray et al. to specifically include handoff between a packet and a circuit type system as taught by Rygula et al. for the purpose of having the capability of handing off calls between different systems.

3. Consider claim 3, and as applied to claim 23 above, Julka et al. discloses wherein the call transfer request is a call request including an identifier identifying the call request as a call transfer request (col. 8, lines: 42-48).
4. Consider claim 8, and as applied to claim 23 above, Julka et al. discloses a method further comprising sending the call transfer request except upon receipt of a handoff request for the mobile station.

Nonetheless, Ray et al. teaches sending the call transfer request upon receipt of a handoff request for the mobile station (col. 3, lines: 66-67, col. 4, lines: 1-17, Ray et al. teaches that after sending a request the request is then granted and further instruction assign to the mobile).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Surdila et al. to modify sending the call transfer request upon receipt of a handoff request for the mobile station as taught by Ray et al. for the purpose of call set up between the mobile and the new base station system (col. 4, lines: 8-10).

5. Consider claim 9, and as applied to claim 23 above, Julka et al. shows and discloses wherein the first and second networks are one of different networks

and different portions of a same network (Fig. 1 and 2, shows a division by a dotted lines where one of the system networks is labeled 12-1 and the other system network is 12-2, hence, having different networks and different portions of a same network as depicted in the figure).

6. Regarding claim 10, cancelled.

7. Regarding claim 24, Julka et al. discloses and shows a method of transferring a packet switched call over a first network (Fig. 1, 2, & 3, col. 5, lines: 1-67 & col. 6, lines: 1-6, these figures and lines discloses a first network transferring a packet switch call to another network) to a circuit switched call carried over a second network (col. 5, lines: 1-67 & col. 6, lines: 1-6, these figures and lines show the second network interacting with the first network), the packet switched call being between a mobile station and an end point (Fig. 1, figure 1 shows mobile subscriber {22} interacting with base station {18} to an PSTN {34} or endpoint), except comprising: sending a handoff notification request to the handoff notification request requesting that the second technology network send notification when the second technology network receives a handoff request for the mobile station.

Nonetheless, Ray et al. teaches sending a handoff notification request, the handoff notification request requesting sending of a notification if the second network receives a handoff request (col. 3, lines: 43-65, Fig. 2A, shows the mobile user going from cell 22a to cell 22b and as found in the reference the cell does communicate with the system through a base station to handoff from one

system to the other, even though, the figure 2A shows MSC and BSC to be the same for the systems shown, Ray et al. makes it clear in the reference that the system can be the same or different and still be able to communicate, col. 2, lines: 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Surdila et al. to specifically have a sending a handoff notification request, the handoff notification request requesting sending of a notification if the second network receives a handoff request as taught by Ray et al. for the purposes of being able to convert information from one system to the other to have a reliable handoff (col. 4, lines: 20-25).

However, the combination of Julka et al. and Ray et al. does not disclose the handoff between a packet and a circuit type system, however, Rygula et al. discloses handoff between different systems such as packet and circuit type systems (col. 11 lines: 36-47, col. 13 lines: 36-61, Rygula teaches the ability to handoff calls from one system to a different system with different capabilities).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Julka et al. and Ray et al. to specifically include handoff between a packet and a circuit type system as taught by Rygula et al. for the purpose of having the capability of handing off calls between different systems.

8. Consider claim 11, and as applied to claim 24 above, Julka et al. discloses wherein the notification is a call request including an identifier identifying the call request as a call transfer request (col. 8, lines: 42-55, as noted in these lines the request is including an identifier and then system verifies and starts the handoff process).
9. Consider claim 22, and as applied to claim 24 above, Julka et al. shows and discloses wherein the first and second networks are one of different networks and different portions of a same network (Fig. 1, 2, & 3, col. 5, lines: 1-67 & col. 6, lines: 1-6, these figures and lines discloses a first network transferring a packet switch call to another network, they also show in objects 12-1 one network and 12-2 the other network both are encased networks by the dotted lines around them which makes them different, inside they have object that are different portions of a same network).

Claims 2, 6, 12, 14, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julka et al. (U.S. Patent # 6,917,810 B2), in view of Ray et al. (U.S. Patent # 6,424,638 B1), and further in view of Surdila et al. (U.S. Patent Application Publication # 2002/0110104 A1).

10. Consider claim 2, and as applied to claim 23 above, the combination of Julka and Ray teaches the handoff notification request mentioned above except that Surdila et al. shows and discloses wherein an event request established using a SIP SUBSCRIBE request (Paragraphs: [0007], [0011], [0012], & [0021]; Surdila et al. discloses the use of SIP to access a SIP server to access terminals, user

information, and other information necessary to establish and control a call, the terminal sends this SIP message to subscribe or access the CSCF that has everything necessary to establish a call as mentioned above)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the combination of Julka et al. and Ray et al. to specifically have a SIP Subscribe request that would use SIP to subscribe to a system of different capacity of communication as taught by Surdila et al. for the purpose of performing a SIP Subscribe request between different types of wireless systems (Abstract).

11. Consider claim 6, and as applied to claim 3 above, the combination of Julka et al. and Ray et al. does not teach the SIP invite request as being the call request, nonetheless, Surdila et al. discloses wherein the call request is a SIP INVITE request (paragraph [0029], Surdila et al. teaches by SIP invite request and communicates with mobile terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the combination of Julka et al. and Ray et al. to specifically have a SIP invite request as being the call request as taught by Surdila et al. for the purposes of no impact on the core network (Paragraph [0029]).

12. Consider claim 12, and as applied to claim 11 above, the combination of Julka et al. and Ray et al. does not teach a packet call controller and a that the handoff notification includes a network address, nonetheless, Surdila et al. discloses

wherein the handoff notification request includes a network address for addressing a call transfer function for the mobile station in the packet call controller, and the identifier is the network address (Paragraph [0011], Surdila et al. teaches using a SIP that access a SIP mechanism. Surdila et al. also teaches a switching control function which controls data signals to route information to its destination it could not be done without the SIP and functions established).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the combination of Julka et al. and Ray et al. to specifically have a handoff notification include a network address addressing the packet call controller as taught by Surdila et al. for the purpose of providing access to medium communications system (Paragraph [0011]).

13. Consider claim 14, and as applied to claim 11 above, the combination of Julka et al. and Ray et al. does not teach the call request is a SIP invite request, nonetheless, Surdila et al. shows and discloses wherein the call request is a SIP INVITE request (paragraph [0029], Surdila et al. teaches by SIP invites and communicates with mobile terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the combination of Julka et al. and Ray et al. to specifically have a call request is a SIP invite request as taught by Surdila et al. for the purpose of translating the signal (Paragraph [0027]).

14. Consider claim 16, and as applied to claim 24 above, the combination of Julka et al. and Ray et al. does not teach a bearer path between the endpoint and mobile station via the second network, nonetheless, Surdila et al. shows and discloses further comprising: establishing a bearer path between the end point and the mobile station via the second network when the notification is received (Fig. 1 and 2, shows connections between the mobile {31} and the endpoint {23}, paragraphs [0005] & [0018], teaches a bearer path and control between the endpoint and mobile).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the combination of Julka et al. and Ray et al. to include bearer path between the endpoint and the mobile via the second network as taught by Surdila et al. for the purpose of communication services (Paragraph [0005]).

15. Consider claim 18, and as applied to claim 17 below, the combination of Julka et al. and Ray et al. does not teach setting up the bearer path at the packet call controller as the call control agent for the second control path, nonetheless, Surdila et al. shows and discloses the establishing step further comprising setting up the bearer path at the packet call controller as the call control agent for the second call control path (Fig. 1 and 2, note: In figure 2 the objects 51 and 52. Also, Paragraph [0027]-[0030], these paragraph talk about the second call path and packet call controller used as such).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of the combination of Julka et al. and Ray et al. to include the bearer path at the packet call controller as the call control agent for the second control path as taught by Surdila et al. for the purpose of accessing multimedia services for the mobile terminal (Paragraph [0012]).

16. Consider claim 19, and as applied to claim 17 below, the combination of Julka et al. and Ray et al. does not teach the control request is a SIP re-invite, nonetheless, Surdila et al. shows and discloses wherein the control request is a SIP re-INVITE request (Fig. 1, Paragraphs [0006] & [0011], note: the system or mechanism is understood to be used to establish communication to exchange information from SIP to a SIP control signaling with the packet-switched radio telecommunications).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of the combination of Julka et al. and Ray et al. to include the control request to be a SIP re-invite request as taught by Surdila et al. for the purposes of accessing multimedia IP network (Fig. 1, Paragraphs [0006] & [0011])

17. Consider claim 20, and as applied to claim 19 above, the combination of Julka et al. and Ray et al. does not teach that the call transfer request is a SIP invite, nonetheless, Surdila et al. shows and discloses wherein the call transfer request

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is a SIP INVITE request (Paragraphs [0006] & [0011], note: As the SIP proceeds to the SIP control it is understood that it is a SIP invite request).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of the combination of Julka et al. and Ray et al. to include the call transfer request to be a SIP invite request as taught by Surdila et al. for the purposes of accessing services render by providers (Paragraph [0011]).

Claims 5, 7, 13, & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julka et al. (U.S. Patent # 6,917,810 B2), in view of Ejzak (U.S. Patent Application Publication # 2003/0026245 A1).

18. Consider claim 5, and as applied to claim 3 above, Julka et al. does not teach that the identifier is a universal resource locator, nonetheless, Ejzak shows and discloses wherein the identifier is a universal resource locator (Paragraph [0057]-[0061], these lines of information provide what the iMSC server does in the system and one of the action it does is to formulate an uniform resource locator (URL) to find address by requesting the system it is looking to handoff).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of the combination of Julka et al. to include the universal resource locator as the identifier as taught by Surdila et al. for the purposes of accessing services render by providers (Paragraph [0057]-[0061]).

19. Consider claim 7, and as applied to claim 6 above, Julka et al. does not teach that the identifier is a request URL, nonetheless, Ejzak teaches the identifier is a request URL for call transfer (Paragraph [0060]&[0061], these paragraph teach that the URL goes through systems to locate destination of service that it can request address).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Julka et al. to include the identifier as a request URL as taught by Ejzak for the purpose of obtain information for exchange (Paragraph [0061]).

20. Consider claim 13, and as applied to claim 11 above, Julka et al. does not teach the identifier is a universal resource locator, nonetheless, Ejzak teaches the identifier is a URL (Paragraph [0057]-[0061], these lines of information provide what the iMSC server does in the system and one of the action it does is to formulate an uniform resource locator (URL) to find address by requesting the system it is looking to handoff these).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Julka et al. to include the identifier to be a URL as taught by Ejzak for the purpose of finding address of targeted service (Paragraph [0061]).

21. Consider claim 15, and as applied to claim 14 above, Julka et al. does not teach the identifier is a request URL provided for the mobile, nonetheless, Ejzak teaches the identifier is a request URL (Paragraph [0060]&[0061], these

paragraph teach that the URL goes through systems to locate destination of service that it can request address).

Therefore, it would have been obvious to a person of ordinary skill at the time the invention was made to modify the teachings of Julka et al. to include the identifier to be a request URL as taught by Ejzak for the purpose of accessing services render by providers (Paragraph [0057]-[0061]).

Claims 4 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surdila et al. (U.S. Patent Application Publication # 2002/0110104 A1), in view of Faccin et al. (U.S. Patent # 6,725,036 B1).

22. Consider claim 4, and as applied to claim 3 above, Surdila et al. discloses wherein the handoff notification request except that it includes a network address for addressing a call transfer function for the mobile station in the packet call controller, and the identifier is the network address.

Nonetheless, Faccin et al. teaches handoff notification request includes a network address for addressing a call transfer function for the mobile station in the packet call controller, and the identifier is the network address (col. 1, lines: 30-67, col. 2, lines: 15-20; Faccin et al. teaches a pointer that access the subscriber data in order to service the mobile from one system to the other).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Surdila et al. to specifically include a network address for addressing a call transfer function for the mobile station in the packet call controller, and the identifier is the network address

as taught by Faccin et al. for the purpose of accessing information of the mobile (col. 1, lines: 30-40).

23. Consider claim 17, and as applied to claim 16 above, Surdila et al. does not shows and discloses wherein the establishing step comprises:

- a. Sending a call control request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point.

Nonetheless, Faccin et al. teaches Sending a call control request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point (Fig. 1, col. 2, lines: 5-20, col. 4, lines: 13-64, shows the subscriber communicating with DNS. The subscriber's information is sent to the endpoint to view information and different cases are illustrated with the different systems connecting with the subscriber equipment).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Surdila et al. to specifically requesting from the end point approval from subscriber from another system now in a different system as taught by Faccin et al. for the purpose of knowing what service levels to provide and what services are subscribed to the subscriber (col. 1, lines: 35-40). Consider claim 18, and as applied to claim 17

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above, Surdila et al. discloses a method wherein the establishing step further comprising: setting up the bearer path at the packet call controller as the call control agent for the second call control path (Paragraphs [0005] & [0018], Surdila et al. teaches a bearer path in IP- based networks).

Allowable Subject Matter

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diego Herrera whose telephone number is (571) 272-0907. The examiner can normally be reached on Monday-Thursdays, 6:30 AM-3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid G. Lester can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DH



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